UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,675	07/09/2001	Olga Bandman	PF-0531 USN	8931

7590 06/30/2003

Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER
MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 06/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/701,675	Applicant(s) Bandman et al.
	Examiner Prema Mertz	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 9, 2001*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-23* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/US99/12903. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1-13, drawn to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5, a nucleic acid encoding the polypeptide, an expression vector, a host cell and a method for producing the polypeptide.

Group II. Claims 1-13, drawn to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1, a nucleic acid encoding the polypeptide, an expression vector, a host cell and a method for producing the polypeptide.

Group III. Claims 1-13, drawn to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2, a nucleic acid encoding the polypeptide, an expression vector, a host cell and a method for producing the polypeptide.

Group IV. Claims 1-13, drawn to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3, a nucleic acid encoding the polypeptide, an expression vector, a host cell and a method for producing the polypeptide.

Group V. Claims 1-13, drawn to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4, a nucleic acid encoding the polypeptide, an expression vector, a host cell and a method for producing the polypeptide.

Group VI. Claim 14 drawn to an antibody to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group VII. Claim 14 drawn to an antibody to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group VIII. Claim 14 drawn to an antibody to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group IX. Claim 14 drawn to an antibody to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group X. Claim 14 drawn to an antibody to a polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XI. Claim 14 drawn to an agonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XII. Claim 14 drawn to an agonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group XIII. Claim 14 drawn to an agonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group XIV. Claim 14 drawn to an agonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group XV. Claim 14 drawn to an agonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4.

Group XVI. Claim 15 drawn to an antagonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XVII. Claim 15 drawn to an antagonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group XVIII. Claim 15 drawn to an antagonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group XIX. Claim 15 drawn to an antagonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group XX. Claim 15 drawn to an antagonist of the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4.

Group XXI. Claims 17, 19, 21, drawn to a method of treatment comprising administering the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XXII. Claims 17, 19, 21, drawn to a method of treatment comprising administering the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group XXIII. Claims 17, 19, 21, drawn to a method of treatment comprising administering the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group XXIV. Claims 17, 19, 21, drawn to a method of treatment comprising administering the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group XXV. Claims 17, 19, 21, drawn to a method of treatment comprising administering the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4.

Group XXVI. Claims 18, 20, drawn to a method of treatment comprising administering an antagonist to the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XXVII. Claims 18, 20, drawn to a method of treatment comprising administering an antagonist to the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group XXVIII. Claims 18, 20, drawn to a method of treatment comprising administering an antagonist to the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group XXIX. Claims 18, 20, drawn to a method of treatment comprising administering an antagonist to the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group XXX. Claims 18, 20, drawn to a method of treatment comprising administering an antagonist to the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4.

Group XXXI. Claims 22-23, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:5.

Group XXXII. Claims 22-23, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:1.

Group XXXIII. Claims 22-23, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:2.

Group XXXIV. Claims 22-23, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:3.

Group XXXV. Claims 22-23, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising an amino acid sequence set forth in SEQ ID NO:4.

The inventions listed as Groups I-XXXV do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

The PCT rules define a special technical feature as a feature which defines a contribution over the prior art. The first claimed invention of Group I fails to recite such a feature, since a nucleic acid with a 98.9% identity in a 531bp overlap with SEQ ID NO:6 is disclosed in the prior art (EMBL database Accession number AA280100, 1997). Since the first claimed invention lacks a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention. The invention of Groups I-V are patentably distinct from the products of Group VI-XX because the products of Groups I-V can be used in methods that are materially different from the therapy of Groups XXVI to XXX, such as in the production of antibodies. The methods of Groups XXI to XXV are distinct because each recites method steps not required by the other. Furthermore, the methods are independent and distinct, each from the other, because the methods are practiced with materially different products which are structurally and chemically different, the

novelty of the inventions lying in the products being administered and not the processes. Distinctness is further shown because each of the products in each method can be made and used without any one or more of the other products.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
June 12, 2003